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112701-707

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EXAMINER

GWARTNEY, ELIZABETH A

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

02/22/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

### ATTACHMENT TO ADVISORY ACTION

Applicants' amendment to the claims filed on 01/29/2010 has been fully considered but is denied entry for the following reasons:

First, the amendment raises new issues that require further consideration under 35 USC § 112 1<sup>st</sup> paragraph. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 9-10 and 15 were amended to recite "and a supplementary ingredient selected from the group consisting of minerals, vitamins, prebiotics, probiotics, and combinations thereof." While there is support in the specification for a *film formulation comprising* supplementary ingredients such as coloring, flavors, minerals, vitamins, prebiotics and/or probiotics ([0027]), there is no support for a heat resistant fat-based confectionery product comprising a film coating *and* a supplementary ingredient.

Second, the amendment raises new issues that would require further search given that such limitations were never previously presented in the claims.

Given Applicants' amendment has been denied entry, arguments directed to the amendment have not been addressed.

With regards to the rejection under 35 U.S.C. §112, second paragraph, it is noted that *if* the amendment was entered, the rejection would be withdrawn.

Applicants argue that either Woznicki, Cooking Light or Bon Appétit suggest that the confectionery product may have a film coating having a thickness from 1 micrometer to 1 millimeter. Applicants disagree that that the amount of film coating and film thickness would

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have been considered a result effective variable. Applicants submit that the thickness of the film coating would be understood as providing heat stability and heat resistance to the confectionery product underlying the film coating.

However, because factors such as coating smoothness, shininess and hardness are variables that can be modified by adjusting the amount of film coating and thickness film coating on a confectionery product, absent evidence to the contrary, the precise amount film coating and film coating thickness would have been considered result effective variables by one of ordinary skill in the art at the time of the invention.

Because there is substantial evidence to support determination of a prima facie case of obviousness over each of the applied prior art references, the burden of proof was properly shifted to the applicants to rebut the prima facie case by presenting persuasive arguments or evidence (e.g. unexpected results). *In re Mayne*, 104 F.3d 1339, 1343, 41 USPQ2d 1451, 1455 (Fed. Cir. 1997). ("With a factual foundation for its prima facie case of obviousness shown, the burden shifts to applicants to demonstrate that their claimed fusion proteins possess an unexpected property over the prior art."). Applicants have not met their burden. While applicants find that that film coating thickness and the amount of film coating are not result effective variables, applicants have not provided any evidence to the contrary (i.e. unexpected results). While film coating thickness may provide heat stability and heat resistance to the confectionery, other variables such as smoothness, shininess and hardness also change as a function of film coating thickness and amount.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Gwartney whose telephone number is (571) 270-3874. The examiner can normally be reached on Monday - Friday; 7:30AM - 3:30PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. G./

Examiner, Art Unit 1794

/Keith D. Hendricks/

Supervisory Patent Examiner, Art Unit 1794